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09/448,253	11/24/1999	ALAN EDWARD BELL	AM9-99-0122	4831

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SAN DIEGO, CA 92101

EXAMINER
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SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/448,253

Applicant(s)

LOTSPIECH ET AL.

Examiner

Cristina O Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the amendment filed May 2, 2003. Claims 1,7,13, 21, and 23 have been amended. Claims 1-8 and 13-24 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-8 and 13-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Cookson (US 6,591,365B1).

5. Regarding claim 1 –

Cookson discloses a computer-based system for inhibiting unauthorized recording of digitized music, comprising a cryptography module including logic executable by a provider computer, the logic including, for at least a segment of the music, obtaining an authorized digital signature, and then associating the authorized digital signature with the music, the authorized digital signature being obtained solely by hashing the segment with a cryptographic hash function, no user identification being used; and a

consumer module associated with a consumer music player and executable thereby to undertake logic including processing at least the segment of the music to obtain a test digital signature, and, only if the test digital signature matches the authorized digital signature, permitting at least one of: compression of the music, and recording the music, on the consumer music player (e.g. col 2 ln 15-30).

6. Regarding claim 2 –

Cookson discloses the system of Claim 1, wherein the cryptography module derives authorized digital signatures for respective plural segments of the music, and associates the authorized digital signatures with the music (e.g. col 2 ln 60-65).

7. Regarding claim 3 –

Cookson discloses the system of Claim 2, wherein the consumer module determines test digital signatures for respective plural segments of the music, the consumer module preventing at least one of compression of the music, and recording of the music, unless a predetermined relationship exists between test digital signatures and the authorized digital signatures (e.g. col 3 ln 1-8).

8. Regarding claim 4 –

Cookson discloses the system of Claim 1, wherein the music is stored in a data stream on a disk, and the authorized digital signature is associated with the music by storing the authorized digital signature on the disk, apart from the stream (e.g. col 5 ln 40-65).

9. Regarding claim 5 –

Cookson discloses the system of Claim 1, wherein the music is stored in a data stream on a disk, and the authorized digital signature is associated with the music by storing the authorized digital signature on the disk as part of the stream (e.g. col 5 ln 40-65).

10. Claims 7 - 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cookson (US 6,591,365B1).

11. Regarding claim 7

Cookson discloses a computer program storage device including a program of instructions for determining whether a request to compress and record digitized music should be honored, the program of instructions including computer readable code means for processing at least one segment of the music to obtain a test digital signature; computer readable code means for receiving an authorized digital signature associated with the music; and computer readable code means for permitting compression and recording of the music only if at least the test digital signature matches the authorized digital signature music by storing the authorized digital signature on the disk as part of the stream (e.g. col 2 ln 15-30).

12. Regarding claim 8 –

Cookson discloses the device of Claim 7, further comprising: computer readable code means for determining test digital signatures for respective plural segments of the music; and computer readable code means for preventing at least one of compression of the music, and recording of the music, unless a predetermined number or percentage of matches exist between test digital signatures and authorized digital signatures music

by storing the authorized digital signature on the disk as part of the stream (e.g. col 3 ln 1-8).

13. Claims 13 - 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cookson (US 6,591,365B1).

14. Regarding claim 13 –

Cookson discloses a method for facilitating the compression and storage, on a personal music player, of digitized music received on a disk in an authorized transaction, comprising the acts of recording the music on the disk along with at least one authorized digital signature derived from the music; receiving the disk; engaging the disk with a personal music player compression device; deriving at least one test digital signature from the music; and compressing the music and recording the music on the personal music player only if the test digital signature matches the authorized digital signature (e.g. col 2 ln 15-30).

15. Regarding claim 14 –

Cookson discloses the method of Claim 13, further comprising the acts of deriving plural authorized digital signatures from respective segments of the music; and recording the plural authorized digital signatures on the disk (e.g. col 2 ln 60 – col 3 ln 5).

16. Regarding claim 15 –

Cookson discloses the method of Claim 14, further comprising the acts of: deriving plural test digital signatures from plural segments of the music; and

undertaking the compressing and recording act only if a predetermined number or percentage of matches exists between test digital signatures and authorized digital signatures (e.g. col 2 ln 60 – col 3 ln 5).

17. Regarding claim 16 –

Cookson discloses the method of Claim 13, wherein the authorized digital signature is stored on the disk, apart from the music (e.g. col 2 ln 25-35).

18. Regarding claim 17 –

Cookson discloses the method of Claim 13, wherein the authorized digital signature is stored on the disk in the music (e.g. col 5 ln 40-65).

19. Regarding claim 19 –

Cookson discloses the system of Claim 4, further comprising a robust watermark on the disk (Col 2 ln 60 – col 3 ln10).

20. Regarding claim 20 –

Cookson discloses the method of Claim 13, further comprising recording a robust watermark on the disk (Col 2 ln 60 – col 3 ln10).

21. Claims 21 - 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Cookson (US 6,591,365B1).

22. Regarding claim 21 –

Cookson discloses a computer program storage device including a program of instructions for determining whether a request to compress and record digitized music should be honored, the program of instructions undertaking method acts comprising processing at least one segment of the music to obtain a test digital signature; receiving

an authorized digital signature associated with the music; and permitting compression and recording of the music only if at least the test digital signature matches the authorized digital signature (e.g. col 2 ln 15-30).

23. Regarding claim 22 –

Cookson discloses the device of Claim 21, wherein the method acts further comprise: determining test digital signatures for respective plural segments of the music; and preventing at least one of compression of the music, and recording of the music, unless a predetermined number or percentage of matches exist between test digital signatures and authorized digital signatures (e.g. col 3 ln 1-8).

24. Claims 23 - 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Cookson (US 6,591,365B1).

25. Regarding claim 23 –

Cookson discloses a method for facilitating the compression and storage, on a personal music player, of digitized music received on a disk in an authorized transaction, comprising the acts of engaging the disk with a personal music player compression device; deriving at least one test digital signature from the music; and compressing the music and recording the music on the personal music player only if the at least one test digital signature matches at least one digital signature received on the disk (e.g. col 2 ln 15-30).

26. Regarding claim 24 –

Cookson discloses the method of Claim 23, further comprising the acts of:



deriving plural authorized test digital signatures from respective segments of the music; and comparing the test digital signatures with authorized digital signatures on the disk (e.g. col 3 ln 1-8).

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cookson (US 6,591,365B1) in view of Moskowitz et al (US 5,822,432A).

29. Regarding claims 6 and 18 –

Moskowitz discloses a system and method the authorized digital signature is tagged with a signature date, and the consumer module processes the music using a current key or an expired key having a key date equal to or later than the signature date (e.g. col 9 ln 40-55).

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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